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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,610	02/27/2004	Roy K. Lim	4002-3438	9038
7590	01/11/2006		EXAMINER	
Woodard, Emhardt, Moriarty, McNett & Henry LLP Bank One Center/Tower Suite 3700 111 Monument Circle Indianapolis, IN 46204-5137			KIM, JOHN	
			ART UNIT	PAPER NUMBER
			3733	
DATE MAILED: 01/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

TJ

Office Action Summary	Application No.	Applicant(s)
	10/789,610	LIM, ROY K.
	Examiner	Art Unit
	John Kim	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-67 is/are pending in the application.
 - 4a) Of the above claim(s) 32-37 is/are withdrawn from consideration.
- 5) Claim(s) 38-67 is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 February 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/3/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-31 and 38-67 in the reply filed on December 15, 2005 is acknowledged. The applicant's argument of election with traversal is on the ground(s) that "searching and examining the entire application can be made without serious burden." This is not found persuasive because "a serious burden on the examiner may be shown by prima facie if the examiner shows by appropriate explanation of separate classification" (see MPEP § 808.02). In the instant case, the inventions, as shown in the restriction requirement, have separate classifications.

Claims 32-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 15, 2005.

The requirement is still deemed proper and is therefore made FINAL.

Examiner Comments

From the previous office action, it was noted that the application was filed with two separate and distinct specifications. Applicant decision, filed on December 15, 2005, to delete the second specification (pages 31-39) is acknowledged.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "sleeve at least partially surrounding said rod" as in claim 1 and "sleeve includes an end portion adapted to contact at least one of the group consisting of a spinal rod, an orthopedic connector, and an orthopedic plate" as in claim 40 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said rod" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 15-23, and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Beale et al. (US Pat 6440133, in IDS).

In regards to claim 1, Beale teaches of an apparatus having a base (58, 59, 130 and 140), a shaft (100, 120), a plate (80) with an aperture (98a), and a sleeve (88). See figures 1 and 6. In regards to claim 15, 16, and 18, the aperture is partially or uniformly tapered and has a constant diameter section. In regards to claim 17, the plate has a roughed surface (96) adjacent to aperture. In regards to claim 19 and 20, Beale teaches of having plate with a rounded surface (91a) and shaft with an indentation (102,

102b), which are adjacent to each other. In regards to claim 21, Beale teaches of having a sleeve (88) with an end portion adapted to contact a spinal rod (R).

In regards to claim 22 and 23, Beale teaches of having a shaft including an elongated portion (120) and a plunger portion (100) that are connected to each other (see figure 10 and 12). The elongated portion has a tongue (128 or 126) and the plunger has a groove (113 or 111), where in the tongue is partially within the groove (see figure 1, at 118 or 119).

In regards to claim 27 - 31, Beale teaches of having a base with an upper portion (140 and 130) and a lower portion (58 and 59) and a closure (139 and 149). Both portions are pivotable to each other. Beale teaches of having a latch (139 and 149).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-14 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beale et al. (US Pat 6440133, in IDS).

In regards to claim 2, Beale discloses the claimed invention except for the ratchet mechanism connected to the base and sleeve. Beale's ratchet mechanism (68, 70, 66b, and 74) is attached to the handle. See figure 1. However, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to have a ratchet mechanism connected to the base and sleeve, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70.

In regards to claim 3 and 4, Beale teaches of having a handle including an actuator (51), with the actuator operating ratchet mechanism when actuator is moved or pivoted relative to base (59). In regards to claim 5, Beale includes a stock (54). In regards to claim 6, 7, and 8, Beale has at least one spring between the actuator (51) and stock (54). The spring is a leaf spring, and half the leaf spring is connected to the actuator and the second half is connected to the stock, where the two halves are connected. See figure 1.

In regards to claim 9 and 11, Beale teaches of using a stop (66b) connected to the ratchet mechanism. Though the stop is not directly attached to the base, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a stop connected to the base and the ratchet mechanism, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. In regards to claim 10, the stop is spring biased (72) towards the first position. In regards to claim 12, Beale teaches of a stop with at least one pawl (66b) that is pivotable to either connect or disengage the ratchet mechanism.

In regards to claim 13 and 14, though Beale only teaches of using one pawl, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the apparatus of Beale having a plurality of pawls, since it has

been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to claims 24 and 25, Beale does not teach of having a spring abut the plunger. However, Beale does teach of having a spring, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a spring connected to the plunger, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the apparatus of Beale having a plurality of springs connected to the plunger, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to claim 26, Beale teaches of having a leaf spring instead of concentric springs. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use concentric springs instead of leaf springs, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 38-67 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 


EDUARDO C. ROBERT
PRIMARY EXAMINER